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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,746	07/06/2001	Brian James Gingras	659/791	4594

7590 12/28/2004

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EXAMINER
JOLLEY, KIRSTEN

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/900,746	GINGRAS ET AL.	
	Examiner	Art Unit	
	Kirsten C Jolley	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/27/04*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-53* is/are pending in the application.

4a) Of the above claim(s) *49-53* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on September 27, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,651,924 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

2. The objections to the specification have been withdrawn in response to Applicant's amendments to the specification.

3. The obviousness-type double patenting rejections set forth in the prior Office action have been withdrawn in response to the filed terminal disclaimer.

4. Applicant's arguments filed September 27, 2004 have been fully considered but they are not persuasive.

With respect to the 103 rejections over the WO 01/40090 A2 (the Perini reference), Applicant argues that Perini says that it would be difficult, if not impossible, to effectuate a successful changeover if the web is wet when it is broken, and that there can be no suggestion or motivation to modify the Perini method to include the breaking of a wet web in view of the teachings in the reference. Applicant further cites *In re Gordon* and MPEP 2143.01, as well as *In re Mills* which states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the

combination." First, it is noted that the rejection over the Perini reference is not made over a *combination* of references, nor is it a modification to Perini's reference. The teaching of breaking a wet web in Perini, while a negative teaching and one that is expected to make the process more difficult, is still a fair teaching and would have been a known modification to one skilled in the art reading the reference with an expectation of success. As stated in the prior Office action, there is nothing in Applicant's arguments or claims to show that Applicant's process is any different or achieves better results than the prior art teaching of Perini. Applicant further states that Perini teaches modifying the teachings disclosed therein would render it unsatisfactory for its intended purpose. The Examiner disagrees. Perini states that the presence of moisture or liquid would make the changeover "difficult"; this is not necessarily a statement that results would be unsatisfactory.

With respect to the perforating step in Perini, Applicant argues that the web in Perini is perforated before it is wetted. This is acknowledged and therefore the Examiner withdraws the statement that Perini's step of perforating reads on "breaking the wet web."

With respect to the 103 rejections over Deacon et al., Applicant argues that the specification at page 24, lines 14-30 defines the term "breaking." This is unconvincing to the Examiner. The cited passage merely describes how an action of pulling the web back "breaks" the web. This is not a clear and limiting definition of the term "breaking" as provided in the claims. Applicant is welcome to amend the claims to clarify that breaking is performed to form to a leading edge, or provide a transverse cut along the web, however no such limitations are required or amendments made thus far. It remains the Examiner's position that the steps of slitting and perforating performed in Deacon et al.'s process meet the limitation of breaking the

wet web. Further, it is noted that while not specifically stated by Deacon et al., it is a well known and normal operation in a manufacturing process to produce multiple smaller rolls from a single larger master roll of the untreated web. A step of breaking the web of Deacon et al. at any point in time during manufacturing to form a second small roll (suitable in size for commercial sale) would read on Applicant's claim 1 which merely requires "breaking the wet web."

Applicant also argues that claim 18 includes the step of "perforating the web" and "breaking the wet web," and that in order to avoid redundancy in the claim language these two words must be interpreted as having distinct and individual meanings. The Examiner notes that for the rejection of claim 18, the step of "breaking the wet web" is considered to the splitting step, such that the perforating and breaking steps have distinct and individual meanings.

Applicant argues that claim 31 includes the step of breaking the wet web and forming a cigarette from the leading edge of the break, which must also be differentiated from a perforation as disclosed in Deacon. The Examiner notes that claim 31 is not rejected over the Deacon et al. reference.

Applicant argues that the speed cannot be a cause-effective variable in Deacon et al. because Deacon fails to teach or even consider the breaking of the wet web while winding the roll and because Deacon fails to teach or suggest the speed at which a wet web could travel. The Examiner disagrees. The Examiner maintains the position that one skilled in the art would have been motivated to maximize the travel speed in order to increase productivity and efficiency of the process, however the travel speed must not be too fast that it causes the wet web to undesirably break or stretch during rolling. One skilled in the art would have recognized that he speed would be dependent upon a number of factors, including the thickness, strength, specific

material and weight of the web, the type and amount of wetting solution supplied, the specific equipment used, etc. It would have been obvious for one having ordinary skill in the art to have optimized the web travel speed through routine experimentation in the absence of a showing of criticality.

With respect to the rejections over Perini in view of Deacon, Applicant argues that Deacon does not disclose that the acrylic resin is water dispersible, and this property appears to have been supplied from the Examiner's personal knowledge. The Examiner maintains that it is known that acrylic resins are water dispersible. The definition of "acrylic resin" from Hawley's Condensed Chemical Dictionary, 14th Edition is cited to demonstrate that acrylic resins may be used in aqueous emulsions, therefore acrylic resins are known to be water dispersible.

Information Disclosure Statement

5. The information disclosure statement filed January 31, 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Japanese publications JP 2-91300, JP 5-209395, and JP 6-306793 have been placed in the application file, but the information referred to therein has not been considered, and the publications have been crossed through on the corresponding PTO-1449.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-7, 9-12, 14, and 16-19, and 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2.

The claims remain rejected for the reasons set forth in the prior Office action as well as for the reasons discussed above in section 4.

8. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 as applied to claims 1-7, 9-12, 14, 16-19, and 21-48 above, and further in view of Deacon et al. (US 4,601,938).

The claims remain rejected for the reasons set forth in the prior Office action as well as for the reasons discussed above in section 4.

9. Claims 1-7, 9-19, and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deacon et al. (US 4,601,938).

The claims remain rejected for the reasons set forth in the prior Office action as well as for the reasons discussed above in section 4.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 or Deacon et al. as applied to claim 18 above, and further in view of Win et al. (US 5,667,635).

The claims remain rejected for the reasons set forth in the prior Office action as well as for the reasons discussed above in section 4.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kirsten C Jolley
Primary Examiner
Art Unit 1762

kcj